

REMARKS

Claims 1-13, 18, 23-25 and 29-30 have been amended. Claims 14-17, 19-22 and 26-28 have been cancelled. Claims 31 and 32 have been newly added. Support for the amendments and the newly added Claims can be found throughout the specification and at least at, for example, para. [0035], para. [0037], para. [0047], para. [0049], para. [0050], FIG. 1, FIG. 9 and FIG. 13. Applicants respectfully submit that no new matter has been introduced. Applicants believe that all of the new Claims have previously been paid for and that no additional Claims fees are due at this time. If any additional fees are due, the Commissioner is hereby authorized to charge all fees due to Attorney's Deposit Account No. 50-3081.

35 U.S.C. § 101 Rejections

Claims 1-17 and 30 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. Claims 1-17

Claim 1 stands rejected under 35 U.S.C. 101 because Claim 1 is directed to "comparing statuses of attributes" but does not produce anything tangible. Claim 1 as currently amended no longer recites "comparing statuses of attributes." Instead, Claim 1 partially recites "...producing a report..." (see para [0047], FIG. 9 and FIG. 13, Applicants' specification). A report is a tangible result with a practical application. Therefore, the Applicants respectfully submit this rejection be withdrawn.

Applicants have amended Claim 1 which Claims 2-13 depend directly from. For the same reasons as discussed above with respect to Claim 1, Applicants respectfully submit the rejection of Claims 2-13 be withdrawn.

Applicants have cancelled Claims 14-17. Therefore, Applicants respectfully submit the rejection of Claims 14-17 be withdrawn.

b. Claim 30

Claim 30 stands rejected under 35 U.S.C. 101 because Claim 30 is directed to "comparing received statuses of attributes" but does not produce anything tangible. Claim 1 as

currently amended no longer recites “comparing statuses of attributes.” Instead, Claim 1 partially recites “...producing a report...” (see para [0047], FIG. 9 and FIG. 13, Applicants’ specification). A report is a tangible result with a practical application. Therefore, the Applicants respectfully submit this rejection be withdrawn.

35 U.S.C. § 112 Rejections

Claims 1-29 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

a. Claim 1

Claim 1 stands rejected under 35 U.S.C. § 112 due to the phrase “comparing statuses of attributes” as being unclear how a status of an attribute can be compared with another status of an attribute. Claim 1 as currently amended no longer recites “comparing statuses of attributes.” Instead, Claim 1 partially recites “calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans;...” (See FIG. 1, Applicants’ Specification). For example, attributes can have a value equal to a true or false or attributes can have a value equal to a number. Id. Therefore, the Applicants respectfully submit this rejection be withdrawn.

b. Claim 9

Claim 9 stands rejected under 35 U.S.C. § 112 due to the phrase “are performed by the same entity” because the phrase does not make sense within the structure of the claim. Claim 9 as currently amended no longer recites “are performed by the same entity.” Instead, Claim 9 partially recites “... a single system associated with a single record keeper entity performs record keeping functions for at least two of the other sponsor provided benefit plans.” (See para. [0035], Applicants’ Specification). Therefore, the Applicants respectfully submit this rejection be withdrawn.

c. Claim 18

Claim 18 stands rejected under 35 U.S.C. § 112 due to the phrase “uniquely associated” because it is not clear what the applicant means by uniquely associating. Claim 18 as currently amended no longer recites “uniquely associated.” Instead, Claim 18 partially recites “...defining one or more first action items associated with the first attribute and one or more second action items associated with a second attribute” (See para. [0050], Applicants’ Specification). Therefore, the Applicants respectfully submit this rejection be withdrawn.

Claim 18 also stands rejected under 35 U.S.C. § 112 due to the phrase “receiving the status of one or more of the one or more attributes” because the language is not clear. Claim 18 as currently amended no longer recites “receiving the status of one or more of the one or more attributes.” Instead, Claim 18 now depends from Claim 1 which partially recites “...value of the first attribute...value of the second attribute...” (See FIG. 1, Applicants’ Specification). For example, attributes can have a value equal to a true or false or attributes can have a value equal to a number. *Id.* Therefore, the Applicants respectfully submit this rejection be withdrawn.

Claim 18 also stands rejected under 35 U.S.C. § 112 due to the phrase “status” because it is unclear how the application defines status in the context of the Claim. Claim 18 as currently amended no longer recites “status.” Instead, Claim 18 now depends from Claim 1 which partially recites “...value of the first attribute...value of the second attribute...” (See FIG. 1, Applicants’ Specification). For example, attributes can have a value equal to a true or false or attributes can have a value equal to a number. *Id.* Therefore, the Applicants respectfully submit this rejection be withdrawn.

d. Claim 26

Claim 26 stands rejected under 35 U.S.C. § 112 due to the phrase “metric” because it is unclear which attributes are associated with which metrics. Claim 26 is currently cancelled. Therefore, the Applicants respectfully submit this rejection be withdrawn.

e. Claims 2-8, 10-17, 19-25 and 27-29.

Claims 2-8, 10-13, 23 to 25 and 29 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly Claim the subject matter which applicant regards as the invention. Applicants have amended Claim 1 which Claims 2-8, 10-13, 23 to 25 and 29

depend directly or indirectly from. For the same reasons as discussed above with respect to Claim 1, Applicants respectfully submit the rejection of Claims 1-8, 10-13 and 23 to 25 be withdrawn.

Applicants have cancelled Claims 14-17, 19-22 and 27-28. Therefore, Applicants respectfully submit the rejection of Claims 4-17, 19-22 and 27-28 be withdrawn.

35 U.S.C. § 102 Rejections

Claims 1-4, 6-11, and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mahoney et al. (U.S. Publication No. 20030182147 filed January 6, 2003). Applicants respectfully disagree and traverse this rejection. In order for a claim to be anticipated by a reference, the reference must teach each and every element of the claim. Applicants respectfully submit that Applicants' Claims 1-4, 6-11, and 13 are not anticipated by the cited reference at least because Mahoney fails to teach calculating a metric for a sponsor provided benefit plan and calculating an aggregate metric for other sponsor provided benefit plans, as required in Applicants' amended Claims 1-4, 6-11, and 13.

Applicants' amended Claim 1 partially recites, "calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans;..." Mahoney discloses tools for the sponsor of the plan to be aware of the aggregate financial impacts of the participants elections," in real time or near real time. (See, for example, Mahoney, para. [0035] and para. [0037]). Mahoney further discloses a sponsor selects a record keeper. The record keeper provides prototype applications to provide the sponsor with different representative plans to demonstrate commonly selected plan options. (See, for example, Mahoney, para [0063] and para. [0064]). Mahoney does not disclose calculating an aggregate metric of other sponsor provided plans. Calculating an aggregate metric of other sponsor provided benefit plans requires the accumulation of values of attributes of different plans provided by different sponsors. (See, for

example, para. [0035] and para. [0049], Applicants' Specification). Determining the aggregate financial impact of participants of a plans elections does not allow the calculation of an aggregate metric based on the accumulation of values of attributes of different plans provided by different sponsor. Since Mahoney fails to disclose "calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans;..." Applicants submit that Mahoney fails to anticipate Applicants' amended Claim 1 for at least the foregoing reasons.

In turn, Mahoney does not teach each and every element of Applicants' Claims 2-4, 6-11, and 13 which depend, directly or indirectly, from Claim 1 for the same reasons.

35 U.S.C. § 103(a) Rejections

a. Claim 5

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mahoney in view of Manning (U.S. Publication 2004/0088236 filed October 31, 2002). To establish obviousness the combination must teach or suggest all of the elements of Applicants' Claims. In this instance, the cited references, alone or in combination, do not teach or suggest all of the elements of Applicants' amended claims.

Applicants' amended Claim 1 partially recites, "calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans;..." As discussed above, Mahoney does not disclose these elements. Further, Manning does not cure this defect. As discussed by the examiner, Manning teaches an analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee

benefit plan options. (See, page 7, Office Action, mail date March 12, 2008). Manning does not disclose calculating an aggregate metric of other sponsor provided plans. Calculating an aggregate metric of other sponsor provided benefit plans requires the accumulation of values of attributes of different plans provided by different sponsors. (See, for example, para. [0035] and para. [0049], Applicants' Specification). Analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee benefit plan option does not allow for the calculation of an aggregate metric based on the accumulation of values of attributes of different plans provided by different sponsor. Since Manning fails to disclose "calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan, calculating a second metric based on a value of the second attribute of the first sponsor provided plan, calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans and calculating a second aggregate metric based on values of the second attribute of the other sponsor provided benefit plans." Applicants respectfully submit that Mahoney in view of Manning fails to make obvious Applicants' amended Claim 1.

Claims 5 depends from Applicants' amended Claim 1 and thus is not obvious for at least the same reasons amended Claim 1 is not obvious.

b. Claims 12, 14-17, and 26-28.

Claims 12, 14-17, and 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mahoney in view of Newman (U.S. Publication 2002/0103680 filed January 1, 2002). To establish obviousness the combination must teach or suggest all of the elements of Applicants' Claims. In this instance, the cited references, alone or in combination, do not teach or suggest all of the elements of Applicants' amended claims.

Applicants' amended Claim 1 partially recites, "calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans;..." As discussed above, Mahoney does

not disclose these elements. Further, Newman does not cure this defect. Instead, Newman discloses linking together the claims data of a number of different groups to perform plan design modeling. (See Newman, para. [0208]). The plan design modeling become an actuarial modeling tool to link together the claim records of multiple groups to determine, for example, how to pool the number of different groups resources together. Id. Newman does not disclose calculating a first metric based on a value of a first sponsor provided benefit plan and calculating an aggregate metric of other sponsor provided plans. Since Newman fails to disclose “calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans;...” Applicants respectfully submit that Mahoney in view of Newman fails to make obvious Applicants’ amended Claim 1.

Claims 12 depends from Applicants’ amended Claim 1 and thus is not obvious for at least the same reasons amended Claim 1 is not obvious.

Claims 4-17, and 26-28 have been cancelled, thus Applicants respectfully request the rejection of Claims 4-17 and 26-28 be withdrawn.

c. Claim 18-22, 24-25, and 29

Claims 18-22, 24-25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mahoney in view of Manning. To establish obviousness the combination must teach or suggest all of the elements of Applicants’ claims. In this instance, the cited references, alone or in combination, do not teach or suggest all of the elements of Applicants’ amended claims.

Applicants’ amended Claim 1 partially recites, “calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...calculating a second aggregate metric based on values of the second attribute of

the subset of the other sponsor provided benefit plans;...” As discussed above, Mahoney does not disclose these elements. Further, Manning does not cure this defect. As discussed by the examiner, Manning teaches an analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee benefit plan options. (See, Office Action, mail date March 12, 2008, page 7). Manning does not disclose calculating an aggregate metric of other sponsor provided plans. Calculating an aggregate metric of other sponsor provided benefit plans requires the accumulation of values of attributes of different plans provided by different sponsors. (See, for example, Applicants’ Specification, para. [0035] and para. [0049]). Analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee benefit plan option does not allow the calculation of an aggregate metric based on the accumulation of values of attributes of different plans provided by different sponsor. Since Manning fails to disclose “calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan, calculating a second metric based on a value of the second attribute of the first sponsor provided plan, calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans and calculating a second aggregate metric based on values of the second attribute of the other sponsor provided benefit plans.” Applicants respectfully submit that Mahoney in view of Manning fails to make obvious Applicants’ amended Claim 1.

Claims 18, 24-25, and 29 depend directly or indirectly from Applicants’ amended Claim 1 and thus are not obvious for at least the same reasons amended Claim 1 is not obvious.

d. Claim 30

Applicants’ amended Claim 30 partially recites, “means for calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan; means for calculating a second metric based on a value of the second attribute of the first sponsor provided plan;...means for calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans;...means for calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit

plans;...” For at least the same reasons as amended Claim 1, Mahoney in view of Manning fails to make obvious Applicants' amended Claim 30.

CONCLUSION


Applicants' discussion of particular positions of the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicants. Applicants' emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable. Applicants' amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form.

In view of the foregoing remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Applicants respectfully request consideration and allowance of claims 1-13, 18, 23-25 and 29-32 and cancellation of claims 14-17, 19-22 and 26-28. The Examiner is respectfully requested to telephone the undersigned at (617) 526-9887 to discuss any further issues in this matter.

Respectfully submitted,

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